

Application No. 10/765,341
Reply to Office Action dated April 28, 2005
Reply to Office Action of February 23, 2005

and (2) would have been properly finally rejected on the grounds and art of record in the next Office Action if they had been entered in the earlier application." (MPEP § 706.07(b) (May 2004)). Applicant respectfully disagrees with the Examiner's contention that "[a]ll claims...could have been finally rejected on the grounds and art of record in the next Office Action if they had been entered in the earlier application." (Office Action, page 3, paragraph 2). Independent claim 1 of the present application is substantially identical to independent claim 47 as amended in Applicant's Amendment dated November 8, 2002 in the earlier application, Application No. 09/790,008 (the "'008 application"). A copy of the November 2002 Amendment is attached hereto. In the Office Action dated December 9, 2002, the Examiner rejected claim 47 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,752,161 to Bent ("Bent") in view of U.S. Patent No. 4,777,948 to Wright ("Wright"). Applicant respectfully brings to the Examiner's attention that the prior rejection was on the same grounds and art that is being applied to reject the claims in the present Office Action. In the earlier application, Applicant submitted arguments in an Amendment dated March 7, 2003 to overcome the rejection. In the next action, the Examiner indicated that "[c]laims 47-55, 57-68, 70 and 71 are free of any rejection based upon the prior art of record." (Office Action dated April 9, 2003 from the '008 application, page 3, paragraph 2).

Claim 47 was also rejected under obvious-type double patenting in view of U.S. Patent No. 5,451,227. Applicant believed at the time that it was unnecessary to subject claim 47 to a Terminal Disclaimer with '227 patent because claim 47 was directed to a rongeur having a "tubular member." The remainder of the claims in the earlier application did not recite a "tubular member." Accordingly, Applicant cancelled independent claim 47 and its dependent claims from the '008 application subsequent to the April 2003 Office Action.

The claims could not have been properly finally rejected if entered in the earlier application.

Applicant respectfully submits that the finality of the present Office Action is improper because Applicant overcame the Examiner's rejection of essentially the same

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independent claim in view of the same art in the earlier application. If the claims had not been cancelled in the earlier application, the next action could not have been a final action by the Examiner based on the same art rejection. The Examiner would have had to first withdraw the indicated allowability of claim 47 over the art of record and then re-assert the former rejection. Moreover, Applicant has not changed the claim in such a way as to warrant a new ground of rejection. Accordingly, Applicant respectfully requests the Examiner to withdraw finality of the present Office Action pursuant to MPEP § 706.07(d).

II. Remarks pertaining to the Examiner's rejections.

In the Office Action, the Examiner rejected claims 1-14 under 35 U.S.C. § 103(a) as being unpatentable over Bent in view of Wright. Applicant respectfully traverses the Examiner's rejection. Independent claim 1 recites a rongeur having a shaft terminating in a foot plate, a carrier, and a tubular member configured to be removeably insertable into at least a part of the carrier. The shaft is in slideable relationship with the carrier without passing through the tubular member.

Bent teaches a surgical tool having blade members 20, 22 connected via a tongue and groove configuration. (Bent, col. 4, lines 10-14 and Fig. 5). As recognized by the Examiner, Bent does not teach a tubular member that is removably insertable into at least a part of a carrier. (Office Action, page 2, paragraph 1). Wright teaches a tubular cutting element 28 that is radially clamped to the barrel of the surgical tool in a collet-like chucking action via collet-like nut 36. Shaft 38 slides through tubular cutting element 28. (Wright, col. 3, lines 11-24 and Fig. 2). Applicant submits that modifying the Bent device as suggested by the Examiner still does not result in a rongeur having "a tubular member configured to be removeably inserted at least in part into said open interior of said carrier" as recited in claim 1.

Further, Applicant submits that if the device of Bent were modified to have a removeable tubular cutting element as taught by Wright, such a combination would render the Bent device unsatisfactory for its intended purpose as well as change the

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principle of operation of the Bent device. In order to secure the tubular cutting element of Wright to the Bent device, not only would the cross sectional shape of blade members 20, 22 need to be different (see Bent, Fig. 5), but also the Bent tongue and groove configuration would be destroyed to accommodate the radial clamping taught by Wright as being necessary to secure the tubular element to the device. (See Wright, col. 3, lines 11-24 and Fig. 2). (See also MPEP § 2143.01, sections entitled "The Proposed Modification Cannot Render the Prior Art Unsatisfactory for its Intended Purpose," page 2100-129, col. 2, and "The Proposed Modification Cannot Change the Principle of Operation of a Reference," page 2100-132, col. 1 (May 2004)). Accordingly, Applicant submits that independent claim 1 is allowable over the teachings of Bent and Wright, whether alone or in proper combination, and that dependent claims 2-14 dependent from independent claim 1, or claims dependent therefrom are allowable at least due to their dependency from an allowable independent claim.

The Examiner rejected claims 1-14 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-111 of U.S. Patent No. 5,653,713, claims 1-20 of U.S. Patent No. 6,200,320, claims 1-18 of U.S. Patent No. 5,451,227, and claims 1-39 of U.S. Patent No. 6,142,997.

Applicant is submitting concurrently with this Amendment a Terminal Disclaimer of the terminal part of any patent granted in the present application which would extend beyond the expiration of any one of U.S. Patent Nos. 5,451,227; 6,200,320; 6,695,849; 5,653,713; and 6,142,997.

Applicant submits that independent claim 1 is patentable and that dependent claims 2-14 dependent from independent claim 1, or claims dependent therefrom, are patentable at least due to their dependency from an allowable independent claim.

In view of the foregoing remarks, it is respectfully submitted that the claims are patentable. Therefore, it is requested that the Examiner reconsider the outstanding rejections in view of the preceding comments. Issuance of a timely Notice of Allowance of the claims is earnestly solicited.

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To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-1066.

Respectfully submitted,

MARTIN & FERRARO, LLP

Dated: April 28, 2005

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